

## REMARKS

Claims 1 and 3-23 remain pending.

Independent Claims 1 and 17 are similar. Claim 1 recites,

1. A gaming device comprising:

a housing;

a programmable top light on a top of the housing for conveying information about the gaming device, the top light comprising a plurality of segments, each segment comprising a combination of red, green, and blue light emitting diodes (LEDs);

a programmable controller electrically connected to each of the red, green, and blue LEDs in each segment, the controller comprising variable current sources connected to supply a controllable current to each of the red, green, and blue LEDs in each segment to control intensities of light emitted by each of the red, green, and blue LEDs in each segment; and

the controller also comprising a programmable control portion that is programmable for controlling the variable current sources to supply selected currents to the red, green, and blue LEDs in each segment to cause any of a variety of colors to be emitted from each segment for conveying information about the gaming device, such that the programmable top light may be used in any of a variety of jurisdictions that have different specifications for the color of light emitted by each segment of a top light,

the controller being programmed to cause each of the segments to emit one or more selected colors from the variety of colors that can be emitted from each segment.

**The examiner rejected Claims 1, 3-9, 11-14, 16-18, and 20-23 as being obvious over Applicant's admitted prior art in view of Lys (US 6,720,745).**

The relevant admitted prior art is a top light on a gaming machine that has three colored cylindrical segments stacked on top of each other. The color emitted by each segment is permanently fixed at the factory by selecting a translucent plastic ring of a particular color that surrounds a white light source inside the segment. Different jurisdictions require different colors and orders of the segments in the top light, where the particular segments energized convey different information to a casino operator. Therefore, the top light must be custom tailored for each jurisdiction before affixing it to the slot machine by the manufacturer. This adds construction cost and delay, and the slot machines could not be used in other jurisdictions.

Lys describes a multi-color LED lighting system that can use combinations of red, green, and blue LEDs to create any color, controlled by a computer. Lys gives many examples of the use of computer-controlled lighting, but no use related to a top light for a gaming machine.

The examiner did not identify any prior art that suggested to make the light segments in the top light of a slot machine identical and programmable so that the color emitted by each segment is programmable by a controller to meet the different specifications of jurisdictions, as claimed. The examiner simply concluded that it would have been obvious to use the Lys lighting system for any limitless purpose. Since the use in a top light falls under the "limitless" use, the examiner concluded that the use was obvious.

However, the examiner's rationale prevents all future uses of a programmable multi-colored LED lighting system from being patentable, no matter how inventive the use. The inventiveness of Applicant's invention is not the technology used to create a programmable color, but the non-obviousness in replacing the fixed, jurisdiction-specific color top light with the same top light hardware for each jurisdiction, where the color of each top light segment is programmed by a controller in the gaming machine to display any color in each segment. There are great advantages to the invention, such as being able to ship the identical slot

machine to many different jurisdictions irrespective of the jurisdictions' different specifications for the top light. The casino operators may themselves select one of a plurality of controller settings for setting the segment colors.

Since most inventions are combinations of known things, the examiner must show some suggestion for the combination. Since the prior art is a top light with fixed color segments, and Applicant's invention is an improvement on this top light that saves cost and time, such an invention is very significant and cannot be dismissed using hindsight reconstruction. Those in the industry had not even realized that the prior art top light could be improved upon since it has not changed for 30 years. Applicant thought outside the box and improved on this prior art top light. The examiner, by simply stating it is obvious without any suggestion, does not appreciate that the same top light was used for 30 years without change, and Applicant has just improved it.

As the Federal Circuit outlined in *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (2004), in making the assessment of differences between the prior art and the claimed subject matter, § 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (1983) (noting that "virtually all [inventions] are combinations of old elements"). The "as a whole" instruction prevents evaluation of the invention part by part. *Ruiz*, 357 F.3d at 1275. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. *Id.* This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result—often the essence of invention. *Id.*

See *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072 (1994) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination."); see also *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (1990)

(it is insufficient that prior art shows similar components, unless it also contains some teaching, suggestion, or incentive for arriving at the claimed structure); accord *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051-52 (1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (1985) (it is insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor).

Claim 17 is patentable for the same reasons given above for Claim 1. Accordingly, it is respectfully submitted that all pending claims are patentable.

Should the Examiner have any questions, please call the undersigned at (408) 382-0480 x202.

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/Brian D Ogonowsky/  
Attorney for Applicant(s)

September 2, 2008  
Date of Signature

Respectfully submitted,

/Brian D Ogonowsky/

Brian D. Ogonowsky  
Attorney for Applicant(s)  
Reg. No. 31,988  
Patent Law Group LLP  
2635 N. First St.  
Suite 223  
San Jose, CA 95134  
Tel (408) 382-0480 x202  
Fax (408) 382-0481